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Patrick Vohlgemuth

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EXAMINER

NGUYEN, HANH N

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK VOHLGEMUTH,
PHILIPPE MANFE, and FRANCOIS CZAJKOWSKI

Appeal 2008-2826
Application 10/613,075
Technology Center 2800

Decided: August 28, 2008

Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1 and 3-15. Claim 2 has been canceled. An oral hearing on this

appeal was conducted on August 12, 2008. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to an electric rotary machine which includes a casing, a rotor with a shaft that turns inside the casing, and a fan which is rotated by the rotor. The casing includes at least one air inlet grid and at least one air outlet grid, both of which are made integrally with the casing which is made as a casting. (Spec. 2-3).

Claim 1 is illustrative of the invention and reads as follows:

1. An electric rotary machine comprising:

a casing of elongate shape;

a rotor having a shaft capable of turning inside the casing about an axis of rotation; and

a fan rotated by the rotor;

wherein the casing includes at least one air inlet grid and at least one air outlet grid, both of which are made integrally with the casing, and wherein the casing is made as a casting.

The Examiner relies on the following prior art references to show unpatentability:

Behrend	US 926,086	Jun. 22, 1909
Barnstead	US 3,730,642	May 1, 1973
Geberth, Jr. (Geberth)	US 4,908,538	Mar. 13, 1990
Burke	US 5,182,482	Jan. 26, 1993
Nolte	US 5,283,490	Feb. 1, 1994
Gobled	US 5,717,272	Feb. 10, 1998
Engelbert	US 6,144,137	Nov. 7, 2000
Kaneya	JP 56-49648 A	May 6, 1981

Claims 1, 10-12, and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nolte.

Claims 1 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kaneya.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Geberth.

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Barnstead.

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Barnstead and further in view of Gobled.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Burke.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Behrend.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Nolte in view of Engelbert.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) Under 35 U.S.C § 102(b), does Nolte have a disclosure which anticipates the invention set forth in claims 1, 10-12, and 15?
- (ii) Under 35 U.S.C § 102(b), does Kaneya have a disclosure which anticipates the invention set forth in claims 1 and 14?
- (iii) Under 35 U.S.C § 103(a), with respect to appealed claims 3-9 and 13, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Nolte with varying combinations of the cited secondary references to render the claimed invention unpatentable?

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992)). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder*

Co. v. IRECO, Inc., 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTIONS

I. The rejection of claims 1, 10-12, and 15 based on Nolte

With respect to the 35 U.S.C. § 102(b) rejection of independent claim 1 based on the Nolte reference, the Examiner indicates (Ans. 3) how the various limitations are read on the disclosure of Nolte. In particular, the Examiner directs attention to the illustrations in Figures 1 and 2 of Nolte as well as the accompanying description at column 4, lines 22-45 of Nolte.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Nolte so as to establish a prima facie case of anticipation. Appellants' arguments initially focus on the contention that, in contrast to the claimed invention, Nolte does not disclose an electrical rotary machine in which the air inlet and air outlet grids are made "integral" with the machine casing. According to Appellants (App. Br. 8-10; Reply Br. 1-3), Nolte discloses a structure in which the end brackets 10 and 11, which incorporate the air inlet and air outlet openings, are separately provided with respect to the machine casing 9 and are secured to the rotary machine casing by the bolts 19-22 in bolt unit 8.

After reviewing the disclosure of Nolte in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Answer. In particular, as asserted by the Examiner (Ans. 8), our reviewing court on more than one occasion has interpreted the term "integral" to cover more than a unitary construction. *See, e.g., In re Morris*, 127 F.3d 1048, 1055-56 (Fed. Cir. 1997), *Advanced Cardiovascular Sys. v.*

Scimed Life Sys., 887 F.2d 1070, 1074 (Fed. Cir. 1989), *In re Kohno*, 391 F.2d 959 (CCPA 1968), *In re Dike*, 394 F.2d 584 (CCPA 1968), *In re Larson*, 340 F.2d 965 (CCPA 1965). Further, although Appellants urge in the Briefs that the claim term “integral” must be interpreted as meaning “monolithic” or “one piece,” these terms do not appear in the claim language nor, for that matter, do they appear in Appellants’ original disclosure.

We also find to be unpersuasive the further argument (App. Br. 9-10; Reply Br. 2-3) of Appellants that Nolte does not provide any disclosure of an integral casing structure in which the casing is made as a casting. We do not find Appellants’ arguments to be persuasive in showing any error in the Examiner’s finding (Ans. 4, 9, and 10) that the claimed feature of forming the machine casing by casting is a process limitation which is entitled to no patentable weight in a claim directed to a product. In other words, it is the patentability of the final product *per se* which must be determined. *See In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985).

We do not necessarily disagree with Appellants that, in certain circumstances, manufacturing process steps, such as “casting” in the present factual situation, may impart distinctive structural characteristics and are, therefore, “capable of construction as structural” limitations. *See In re Garnero*, 412 F.2d 276, 279 (CCPA 1969), cited by Appellants (App. Br. 10; Reply Br. 4). We are also cognizant, however, of the holding in *In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983) which concluded that once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with

evidence establishing an unobvious difference between the claimed product and the prior art product.

In the present factual situation presented to us, we find that the Examiner has provided a reasoned analysis for concluding that the final end product in Nolte, i.e., the rotary electrical machine casing with air inlet and air outlet grids, will be the same, or at least structurally equivalent to that claimed. Although Appellants have presented arguments (App. Br. 10; Reply Br. 4) that a casing body made by casting would be structurally distinguished by one skilled in the art from a casing made by other methods, no evidence has been forthcoming from Appellants to support such a conclusion. The arguments of counsel cannot take the place of evidence in the record. *See In re Geisler*, 116 F.3d 1465, 1468 (Fed. Cir. 1997).

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Nolte, the Examiner's 35 U.S.C. § 102(b) rejection of independent claim 1 is sustained. The Examiner's anticipation rejection of dependent claims 10-12 and 15, based on Nolte, is sustained as well. Appellants' arguments with respect to the rejection of dependent claims 10-12 and 15 rely on the alleged lack of Nolte in disclosing a machine casing with an integrally cast construction, which arguments we found to be unpersuasive as discussed *supra*.

II. The rejection of claims 1 and 14 based on Kaneya

This rejection is also sustained. As discussed previously with respect to Nolte, the Examiner has provided a reasoned analysis which finds that the final end product in Kaneya, i.e., the rotary electrical machine casing 1 with the integrally formed air inlet and air outlet grids 11-13 (Kaneya, Figure 1) ,

will be the same or at least structurally equivalent to that claimed. As mentioned above, Appellants have provided no evidence on the record which satisfies their burden of establishing that the claimed rotary machine housing made by a casting process is structurally distinguished from that disclosed by Kaneya.

35 U.S.C. § 103(a) REJECTIONS

We sustain all of the Examiner's obviousness rejections of the claims on appeal. Appellants' arguments (App. Br. 11-14; Reply Br. 5-6) rely on a general allegation that the Examiner has not established a proper basis for the proposed combinations of references but, rather, has merely set forth a desirability for the proposed combinations "in a vacuum."

We find, however, Appellants' arguments to the contrary notwithstanding, that the Examiner, in each instance, has provided an articulated line reasoning (Ans. 5-8) establishing a basis for the obviousness rejections. We find the Examiner's proffered various combinations of Nolte with the secondary references to Geberth, Barnstead, Gobled, Burke, Behrend, and Engelbert reasonably teach and/or suggest Appellants' claimed invention in terms of familiar elements that would have been combined by an artisan having common sense using known methods to achieve a predictable result. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 127 S. Ct. at 1739-40).

CONCLUSION

In summary, we have sustained the Examiner's rejections of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1 and 3-15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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